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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,850	02/27/2004	Vincent J. Gatto	AN-7421	6851
7982                      7590                      10/27/2008 ALBEMARLE CORPORATION PATENT DEPARTMENT 451 FLORIDA STREET BATON ROUGE, LA 70801				
EXAMINER				
OH, TAYLOR V				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
10/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/788,850

**Applicant(s)**

GATTO ET AL.

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-28, 30, 31, 34 and 36-70 is/are pending in the application.
- 4a) Of the above claim(s) 50-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-28, 30-31, 34, 36-49, 69-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/16/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Final Rejection***

**The Status of Claims**

Claims 1,4-28,30-31,34,36-70 are pending.

Claims 1,4-28,30-31,34,36-49,69-70 are rejected.

Claims 50-68 are withdrawn from consideration.

**Claim Rejections-35 USC 103**

1. Applicants' argument filed 7/16/08 have been fully considered but they are not persuasive.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***The rejection of Claims 1,4-28,30-31,34,36-49,69-70 under 35 U.S.C. 103(a) as being unpatentable over Haeberli et al (U.S. 4,228,297) in view of Grant et al (Chemical Dictionary, 1990, p. 11-12).***

The rejection of Claims 1,4-28,30-31,34,36-49,69-70 under 35 U.S.C. 103(a) as being unpatentable over Haeberli et al (U.S. 4,228,297) in view of Grant et al (Chemical Dictionary, 1990, p. 11-12) has been maintained for the reasons of the record on 4/16/08.

### **Applicants' Argument**

2. Applicants argue the following issues:

- a. In all the examples, the first and the second catalyst were different from each other as described in the passages (col. 5, lines 15-18); however, applicants are also aware of the second catalyst which may be selected from the classes of compounds listed for the first alkaline catalyst and it is unclear to the applicants that the second selected catalyst can be the same as the first one;
- b. None of the prior art provide even hint that the use of phosphoric acid in removing the alkali metal catalyst residues is superior to that of acetic acid although acetic acid was found to be workable.
- c. According to the passages in column 10, lines 29-62 of Haeberli, it was necessary for the product to be recovered by crystallization from the liquid filtrate unlike the claimed invention.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first argument, the Examiner has noted applicants' argument. However, as applicants have already acknowledged that the second catalyst may be selected from the classes of compounds listed for the first alkaline catalyst, it does not matter where the piece of information relevant to the claimed invention is found in the prior art; it can be from the examples or the specification of the prior art. Nothing changes a fact that the prior art expressly teaches that the second catalyst may be selected from the classes of compounds listed for the

first alkaline catalyst; in other words, the first and the second catalyst can be the same or they can be different from each other. Therefore, unlike applicants' argument, the prior art is still relevant to the claimed invention.

Second, regarding the second argument, the Examiner has noted applicants' argument. However, applicants have already admitted that the use of acetic acid in the claimed process was found to be workable and yet, applicants emphasize that there is a superiority of using phosphoric acid in removing the alkali metal catalyst residues compared with the acetic acid. Furthermore, applicants did not provide any side-by-side comparison with respect to the difference between the claimed invention and the prior art in yield, etc. Attorney's arguments of the superior result cannot take the place of evidence in the record. Therefore, unlike applicants' argument, the prior art is still relevant to the claimed invention.

Third, regarding the third argument, the Examiner has noted applicants' argument. However, the claimed languages do not exclude the employment of the crystallization in the steps of the claimed process. Also, the expression of the terms "the method comprises" in the claims would suggest the possible inclusion of all kinds of potential limitations relevant to the claimed invention. Therefore, unlike applicants' argument, the prior art is still relevant to the claimed invention.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/  
Primary Examiner, Art Unit 1625  
10/21/08